

PATENT
Customer No. 22,852
Attorney Docket No. 09138.0072

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Rosanne WELCHER) Group Art Unit: 1797
Application No.: 10/539,035) Examiner: Rebecca M. FRITCHMAN
Filed: June 14, 2005)
For: ADVANCE PROGRAMMED) Confirmation No.: 9296
SAMPLE PROCESSING SYSTEM)
AND METHODS OF BIOLOGICAL
SLIDE PROCESSING)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement dated June 9, 2009, the Examiner required restriction under 35 U.S.C. § 121 between Group I, claims 1-55, and 57-59, characterized as being drawn to a method of automated sample processing; and Group II, claim 56, characterized as being drawn to a method of automated sample processing system. Applicant provisionally elects to prosecute Group I, claims 1-55, and 57-59, with traverse.

For a restriction requirement to be proper under U.S. Patent Law, there must be a serious search burden on the examiner. (See M.P.E.P. § 803.) "If the search and examination of all the claims in an application can be made without serious burden, the examiner **must** examine them on the merits, even though they include claims to

independent or distinct inventions." (*Id.*, emphasis added.) In this case, the Office has failed to demonstrate that searching Groups I and II together would impose a serious burden.

Applicant submits that the search of Groups I and II can be made without undue burden because a literature search for these groups would be largely coextensive, since the same search terms would be used to search the prior art. Key words may be chosen that incorporate the inventions in both of the claim groups without serious burden. Moreover, examining these groups separately would impose extra costs and delays on the Office due to the duplicative search and examination that would be involved. Accordingly, Applicant respectfully submits that examining all the claims of Groups I and II together would not impose a serious burden on the Examiner.

In view of at least the foregoing, Applicant respectfully requests that the restriction requirement be withdrawn and that all of claims 1-59 be examined together.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 9, 2009

By: /Jia W. Lu/
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